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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/232,866 01/15/99 RASHIDI

R 96CAD01

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QM32/0619

EXAMINER

SCHAEITZLE, K

ART UNIT

PAPER NUMBER

3762

DATE MAILED:

5
06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/232,866

Applicant(s)

RASHIDI, RASSOLL

Examiner

Schaetzle Kennedy

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 12-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-11 in Paper No. 3 is acknowledged. The traversal is on the ground(s) that one practicing the method of claims 12-17 would result in the catheter of claims 1-11. This is not found persuasive because the method of claim 12 does not require the use of a plurality of electrodes, nor an actuator which simultaneously compresses and tensions first and second tension/compression members. Lacking any specific reasoning as to *why* the method of claims 12-17 would necessarily result in the catheter of claims 1-11, conclusory statements will be ineffective in overcoming the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 12-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 3.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "17" has been used to designate both length adjusters (Fig. 4) and slider links (Fig. 5). Correction is required.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 114' (Fig. 4). Correction is required.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the blade spring member of claim 3 must be shown (it appears that only the wave-shaped spring member has been shown) or the feature(s) canceled from the claim(s). No new matter should be entered.

Specification

6. The disclosure is objected to because of the following informalities: on page 49, the second sentence of the second paragraph (i.e., "An outer blood-contacting casing comprising a tubular flexible...") is grammatically awkward. The examiner has also noted numerous typographical errors in the newly added CIP material (e.g., note lines 3 and 10 of page 49 wherein the words "the" and "which" are misspelled) and has attempted correction by informal examiner's amendment, but recommends the applicant utilize a word processing spellchecker to ensure that all the errors are eliminated.

Appropriate correction is required.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the blade spring member of claim 3 does not appear to be disclosed in the specification.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The handle with the push/pull mechanism (note for example Fig. 4 of the present invention) is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Such means are critical as they allow both tension and compression to be simultaneously applied to the tension/compression members, thus enabling the operator to selectively control and position the distal end.

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10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is vague. It is not clear if the portion of the tension/compression members adjacent the distal end of the hollow tubular casing actually have a flattened transverse section, or if said portion is merely formed to have such a section. The examiner suggests merely replacing the phrase "formed to have" with the word "with."

Claim Rejections - 35 USC § 102/103

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. Claim 1 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Swanson et al. (Pat. No. 5,853,409) in view of Lundquist et al. (Pat. No. 5,254,088).

Swanson et al. show an elongated flexible hollow tubular casing 22 with a plurality of spaced electrodes (note col. 3, lines 49-53) located at a distal end thereof (the examiner takes Official Notice that the second electrode of a bipolar electrode arrangement would necessarily be located in close proximity to the first distal end electrode), a pair of flexible tension/compression members 34 disposed in side-by-side relationship, an electrical lead 32 connected to each of said electrodes (again the examiner takes Official Notice that bipolar electrode arrangements necessarily require separate electrical leads connected to each electrode of the pair), and flexible spacer

means 36 disposed between the pair of flexible tension/compression members at the distal end. Regarding the "wherein" clause (indent (e)), it would appear that longitudinal tensioning of a first of said members 34 would simultaneously result in a longitudinal compression of a second of said members and vice versa. It is further noted that the applicant is not setting forth any tensioning or compression structure such as shown by way of example in Figs. 4 and 5 of the present invention, but is merely stating an intended result if tensioning or compression were to be applied.

In any event, Swanson et al. disclose that the steering mechanism may take the form of those embodiments disclosed by artisans Lundquist et al. (col. 4, lines 22-25). Lundquist et al. shows a variety of steering mechanisms (note in particular Figs. 18 and 19) wherein such behavior of the tension/compression members would necessarily result.

Conclusion

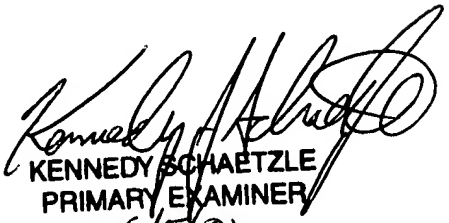
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is (703) 308-2211. The examiner can normally be reached on 9:30 - 6:00.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

KJS
June 5, 2001


KENNEDY SCHAETZLE
PRIMARY EXAMINER
6/5/01